



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/285,249 | 04/02/1999 | JOHN S. HENDRICKS | 5200 | 3419 |

7590

07/17/2002

ALDO NOTO
DORSEY & WHITNEY LLP
1001 PENNSYLVANIA AVE N.W.
SUITE 300, SOUTH TOWER
WASHINGTON, DC 20004

EXAMINER

GRANT, CHRISTOPHER C

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 07/17/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/285,249

Applicant(s)
Hendricks

Examiner
Christopher Grant

Art Unit
2611



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2611

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-16 and 54-55 of U.S. Patent No. 6,201,536.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth.

Art Unit: 2611

For example, note the following relationship between application claim 1 and patented claim 15:

- a) the claimed “*An apparatus for video on demand programs*” (line 1) of application claim 1 corresponds to the “*An apparatus....which stores data and receives communications containing requests from subscribers*” (lines 1-3) of patented claim 15;
- b) the claimed “*a receiver to receive requests for video on demand programs*” (line 2) of application claim 1 corresponds to the “*subscriber requests is received; wherein the subscriber requests include program requests for virtual video on demand “VVOD” programs*”(lines 11-13) of patented claim 15;
- c) the claimed “*a network manager, connected to said receiver, to process said program requests*” (line 3) of application claim 1 corresponds to the “*processing means connected to the identifying means and instruction memory....comprises a processor for executing the stored computer program instructions*” (lines 20-26) of patented claim 15;
- d) the claimed “*an authorization component....to transmit a first authorization code*” (lines 4-5) of application claim 1 corresponds to the “*an authorization means....for authorizing the....*” (lines 27-29) of patented claim 15; and

Art Unit: 2611

e) the claimed ***“a file server, coupled to said network manager, receives said first authorization code, wherein said file server pools said requested program or downloads a second authorization code”*** (lines 6-7) of application claim 1 corresponds to the ***“sending means, connected to the locating means, for sending the located data to the individual subscriber that initiated the subscriber request....for processing”*** (lines 45-49) of patented claim 15.

Note that the limitation of application claim 1 is similar to the limitation of patented claim 15, except that patented claim 15 includes additional subject matter that is not present in application claim 1. Therefore, application claim 1 is broader than patented claim 15.

It would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter, varying in breadth.

The claimed ***“instruction memory”*** subject matter of application claim 2 correspond to the ***“an instruction memory”*** subject matter (lines 18-19) of patented claim 15 because the claims in both the application and the patent are different definitions or descriptions of the same subject matter varying in breadth.

The claimed ***“....control software to compile....”*** subject matter of application claim 3 correspond to the ***“....means for compiling....”*** subject matter (lines 10-11) of patented claim 16

Art Unit: 2611

because the claims in both the application and the patent are different definitions or descriptions of the same subject matter varying in breadth.

The claimed “**....software to deliver or authorize....**” subject matter of application claims 4 and 5 correspond to the “**....authorizing means**” subject matter (lines 27-28) of patented claim 15 or to the “**....authorizing means....**” subject matter (lines 15-18) of patented claim 16 because the claims in both the application and the patent are different definitions or descriptions of the same subject matter varying in breadth.

The claimed “MPEG format” of claim 6 is an obvious modification that provides increase storage capacity.

The claimed “**...request for video on demand programs are received from set top terminals....**” subject matter of application claim 7 correspond to the “**....receives communications containing request....a set top terminal....**” subject matter (lines 2-4) of patented claim 15 because the claims in both the application and the patent are different definitions or descriptions of the same subject matter varying in breadth.

The claimed “**...wherein said authorization component is connected to said network manager by an interface...**” subject matter of application claim 8 correspond to the

Art Unit: 2611

“....interface means, connected to the processing means, for prompting the authorization means to authorize reception...” subject matter (lines 37-40) of patented claim 15 because the claims in both the application and the patent are different definitions or descriptions of the same subject matter varying in breadth.

The claimed subject matter of application claims 9-11, 13-15 and 17 correspond to the subject matter of patented claim 15 because the claims in both the application and the patent are different definitions or descriptions of the same subject matter varying in breadth.

The claimed subject matter of application claim 12 correspond to the subject matter of patented claim 16 because the claims in both the application and the patent are different definitions or descriptions of the same subject matter varying in breadth.

The claimed “MPEG format” and “digital” limitations of claims 16, 18 and 19 are obvious modifications that provides increase storage capacity, robustness and repeatability.

The claimed subject matter of application claims 20-21 and 22-24 correspond to the subject matter of patented claims 15 and 16 respectively because the claims in both the application and the patent are different definitions or descriptions of the same subject matter varying in breadth.

Art Unit: 2611

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wunderlich et al. (Wunderlich) and Farry et al. (Farry).

Considering claim 1, Wunderlich discloses an apparatus for video on demand programs comprising:

- a) a receiver (51) to receive requests for video on demand programs (col. 9, lines 1-3);
- b) a network manager (51) to process said program request (col. 9, lines 4-14);
- c) a file server (52), coupled to the network manager (51), wherein the file server spools the requested program via device (53).

Although Wunderlich discloses authorizing the subscriber to view the requested program (col. 9, lines 15-20 and 23-26), he fails to specifically disclose an authorization component to transmit an authorization code as recited in the claim.

Farry discloses an apparatus (figure 15) for video on demand programs comprising an authorization component (501) that transmits a notification signal (e.g. an authorization code or identification) to a level 1 gateway server (1640) for the advantage of authorizing service to a subscriber. See column 11, lines 1-35.

Art Unit: 2611

It would have been obvious to one of ordinary skill in the art to modify Wunderlich's system (if necessary) to include an authorization component to transmit an authorization code, as taught by Farry, for the typical advantage authorizing service to a subscriber.

Claim 2 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor inherently having an instruction memory for executing the processing of the program request as described at col. 9, lines 4-14.

Claim 3 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor having control software that compile the program requests to determine if a channel is available for a requesting subscriber as described in col. 9, lines 15-25.

Claims 4-5 are met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that file server deliver at least one requested program to the requesting subscriber.

Claim 6 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that programs are stored in MPEG format at col. 7, lines 60-65.

Art Unit: 2611

Claim 7 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that the request for VOD programs are from set top terminals (14) described throughout the reference including but not limited to col. 5, lines 15-20 and col. 9, lines 1-40.

Claim 8 is met by the combined systems of Wunderlich and Farry because the transferring of any signal (including an authorization code) between two equipments has to include an interface device. For example, a printer interface card is necessary in a computer to send data to the printer and an interface is needed in a computer in order to receive input data from a keyboard. Therefore, one of ordinary skill in the art would readily recognize that an interface is a necessary device in the transfer of data between equipments.

Claim 9 is met by the combined systems of Wunderlich and Farry as described in the rejections of claims 3 and 8.

Claims 10 and 17 are met by the combined systems of Wunderlich and Farry as described in the rejections of claims 3 and 8, since Farry's authorization component (501) has to receive a request in order to issue authorization.

Art Unit: 2611

Claim 11 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor inherently having an instruction memory for executing the processing of the program request as described at col. 9, lines 4-14.

Claim 12 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor having control software that compile the program requests to determine if a channel is available for a requesting subscriber as described in col. 9, lines 15-25.

Claim 13 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that the request for VOD programs are from set top terminals (14) described through out the reference including but not limited to col. 5, lines 15-20 and col. 9, lines 1-40.

Claims 14-15 are met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that file server deliver at least one requested program to the requesting subscriber.

Claims 16 and 18-19 are met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses that programs are stored in MPEG format at col. 7, lines 60-65. Note that MPEG programs are digital programs.

Art Unit: 2611

Method claim 20 corresponds to apparatus claim 1 and therefore claim 20 is rejected for the same reasons as described above in the rejection of claim 1.

As for claim 23, the combined systems of Wunderlich and Farry fail to specify authorizing viewing of previews as recited in the claim. The examiner takes Official Notice that programs of various types (such as premium movies, pay-per-view events, concerts, comedy specials, sporting events and previews) are routinely authorized by central facilities for the advantages of providing a variety of services to subscribers and to increase additional revenue for central facilities.

Claim 24 is met by the combined systems of Wunderlich and Farry, wherein Wunderlich discloses a network manager (51) that comprises a processor having control software that compile the program requests to determine if a channel is available for a requesting subscriber as described in col. 9, lines 15-25.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2611

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined systems of Wunderlich and Farry and further in view of Kurisu.

Considering claim 22, the combined systems of Wunderlich and Farry disclose authorization signals and authorizing subscribers in general. However, the combined systems fail to specifically disclose downloading an authorization code as recited in the claim.

Kurisu discloses a CATV system that downloads authorization codes for the advantage of providing a mechanism for enabling set-top terminals to receive special programming events.

See col. 3, lines 1-6.

It would have been obvious to one of ordinary skill in the art to modify the combined systems of Wunderlich and Farry to include downloading an authorization code, as taught by Kurisu, for the advantage of enabling set-top terminals to receive special programming events.

Allowable Subject Matter

7. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2611

Conclusion

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306 0377.



Christopher Grant
Primary Examiner
July 12, 2002